

**REMARKS**

This Amendment is responsive to the Office Action identified above, and is further responsive in any manner indicated below.

**DEFECTIVE OFFICE ACTION**

Applicant respectfully submits that the Office Action mailed 27 March 2003 is defective for the following reasons.

At Item 4 in the Office Action Summary Form PTO-326, Claims 1-59 are properly identified as pending in the present divisional reissue application, with Claims 15-36 indicated as being withdrawn from consideration. At Item 6 in the Summary, Claims 1-14, 37-39 and 44-49 are indicated as being rejected. No status is given for Claims 50-59 in the Summary.

At Item 2 on page 3 of the Detailed Action, Claims 37-39 are indicated as being rejected under 35 USC §103.

At Item 3 on page 4 of the Detailed Action, Claims 40-43 are indicated as being allowable, and at Item 4 on page 4, Claims 1-14 are indicated as being allowed.

Claims 44-49, which are identified as being rejected at Item 6 in the Summary, are not included in any statement of rejection, and no status or mention whatsoever is made of Claims 50-59, with the exception of their proper listing in the pending claims at Item 4 in the Summary.

Therefore, Applicant respectfully submits that the Office Action is defective, and presents this *bona fide* attempt to completely respond to the Office Action.

**OVERLOOKED REQUEST FOR EXAMINER INTERVIEW NOTED**

The undersigned respectfully notes that both the Examiner and the Supervisory Primary Examiner (SPE) have overlooked Applicant's written request for Examiner Interview before a first Action, as set forth in the Preliminary Amendment filed with the present divisional reissue application on 21 November 2001.

Applicant and the undersigned respectfully renew such request for Examiner Interview, and respectfully submit that any continued failure to note Applicant's request for Examiner Interview may be discussed with persons of a higher supervisory role to the Examiner (e.g., the SPE, Group Director, etc.).

**REQUEST FOR INITIALLED FORMS PTO-1449**

Applicant submitted an Information Disclosure Statement and Forms PTO-1449 with the present divisional reissue application on 21 November 2001. Applicant respectfully requests return of the Forms PTO-1449 bearing the Examiner's initials to indicate consideration and entry in the present divisional reissue application, and printing of all information listed therein on the face of any patent issuing on this case.

**STATUS OF CLAIMS AND SUPPORT FOR CLAIM CHANGES**

Claims 1-14 were issued in the original patent upon which the parent reissue application of the present divisional reissue case is based, and Claims 15-59 were submitted in the present divisional reissue application. Unrelated to any prior art, scope or rejection, appropriate claims have been amended herein to adjust a clarity and/or focus of Applicant's claimed invention. More particularly, Claim 37 has been

amended to indicate that the insulating tape is frame shaped, and is continuously formed between the suspension leads and the plurality of leads. Such amendment finds support throughout the present divisional reissue application, *e.g.*, at Column 5, penultimate paragraph, and in Figure 1. Further, Claims 40 and 42 have been amended to be independent and incorporate all of the limitations of Claim 37, from which they depended. All amendments to the claims find full support in the patent as issued and the parent reissue application, as well as the present divisional application. No new matter is added.

At entry of this paper, Claims 1-59 remain pending in this divisional reissue application for consideration and examination.


#### **ALLOWED/ALLOWABLE CLAIMS**

Claims 1-14 have been allowed in the application, as indicated at Item 4 on page 4 of the Detailed Action, and Claims 40-43 have been indicated as being allowable if rewritten, as indicated at Item 3 on page 4. Claims 40 and 42 have been so rewritten. Renewal of allowance of Claims 1-14 and, as clarified, allowance of Claims 40-43, is respectfully requested. Applicant and the undersigned respectfully thank the Examiner for such indication of allowed/allowable subject matter.


#### **RESTRICTION/ELECTION REQUIREMENT - TRAVERSED**

A restriction/election requirement has been made for the reasons beginning at Item 1 on page 2 of the Detailed Action. Applicant respectfully traverses based upon the following grounds.

**NOT INDEPENDENT AND DISTINCT INVENTIONS**

As traversal, Applicant notes that 35 USC §121, the basis for a restriction and election of species requirement, provides for a restriction only if two or more independent and distinct inventions are claimed in one application. While §802.01 of the Manual of Patent Examining Procedure indicates that restriction and/or election of species may be permissible between independent or distinct inventions, such section of the Manual of Patent Examining Procedure is clearly erroneous in view of the plain and unambiguous language of 35 USC §121. 

In this connection, the above-noted section of the Manual of Patent Examining Procedure defines the term "independent" as meaning there is no disclosed relationship between the two or more subjects disclosed that is, they are unconnected in design, operation or effect. It is respectfully submitted that a contention cannot validly be made that the subject matter recited in the claims in issue relating to the respective embodiments of the present invention have no disclosed relationship, for if such is the case, such contentions are clearly without merit as a review of the instant specification and the claimed subject matter reveals.

With further regard to the erroneous restriction/election position presented in the Manual of Patent Examining Procedure (*i.e.*, teaching restriction/election for "independent or distinct inventions", instead of the unambiguous "independent and distinct inventions" statutory language), as pointed out by Mr. McKelvey in the concurring opinion in *ex parte Hartmann*, 186 USPQ 366 (Bd. App. 1974), relying upon the Decision of *ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966) the Manual of Patent Examining Procedure merely provides guidelines for Examiners in the Patent Office and it does not replace, and is subservient to, applicable statutes. 

Rules of Practice, and prior decisions. Thus, by virtue of the plain and unambiguous language of 35 USC §121, the statute only permits an election of species requirement between two or more independent and distinct inventions (not independent or distinct inventions) in spite of the circumlocutory argumentation of §802.01 of the Manual of Patent Examining Procedure.

Moreover, in view of the interrelationship of the inventions designated in the Office Action, and in view of the fact that each of the designated inventions are, in essence, based upon the same basic inventive concept, Applicant respectfully submits that the designated inventions are not independent and distinct to the extent required by 35 USC §121 to support a restriction requirement. In this connection, Applicant notes that a basic inventive concept of the claims in issue relates to forming the leadframe according to chip size, and specifically, the disclosure that the external size of a die pad for mounting the chip is made smaller than the chip, and the leads are made a predetermined length according to the external size of the chip. Applicant respectfully submits that, in view of the claims in issue sharing these features, such claims cannot be considered as rendering respective embodiments independent and distinct to the extent required by 35 USC §121.

In summary, a review of the Office Action reveals that the Office Action has failed to clearly indicate how the subject matter recited in the respective groups of claims represents both independent and distinct inventions are required by 35 USC §121.

**RELATED INVENTIONS - NO SERIOUS BURDEN FOR EXAMINATION**

As further traversal, presuming *arguendo* that one could establish that the subject matter recited in the claims in issue relating to the respective embodiments of the present invention relate to independent and distinct inventions as required by 35 USC §121, as pointed out in §803 of the Manual of Patent Examining Procedure, if a search and an examination of an entire application can be made without serious burden, the Examiner **must** examine the entire application on the merits even though the application includes claims to distinct or independent inventions. In view of the fact that all claims are related to maintenance arrangements (*e.g.*, apparatus, methods, systems, etc.) regarding the size of the die pad and length of leads in accordance with the size of the chip, and given the fact that the allegedly differing sets of Applicant's claims contain similar, analogous and/or overlapping limitations, it is respectfully submitted that search and examination of an entirety of the claims in the instant application would not create a serious burden on the part of the United States Patent and Trademark Office. Accordingly, since the Examiner **must** examine the entire application, the Restriction/Election should be withdrawn.

**PROVISIONAL ELECTION**

In order to comply with the restriction/election requirement, Applicant provisionally elects, with traverse, for prosecution on the merits, Group 1, including at least Claims 1-14 and 37-59.

**NO ADMISSION - RESTRICTION/ELECTION**

Applicant submits that the instant response (including the comments submitted and the provisional election) is not an admission on the record that the respective species are separately distinct species and/or obvious variants.

**CONTINUATION(S)/DIVISIONAL(S) FOR NON-ELECTED SUBJECT MATTER**

Despite any traversal set forth in other parts of this paper regarding any Restriction/Election, Applicant submits that any filing of continuations or divisionals should not be taken as any prejudice, admission or disclaimer that the restriction/election is valid, but instead, that such merely is use of separate applications to move novel subject matter through the patenting process.

**CONTINUATION(S)/DIVISIONAL(S) - DOUBLE PATENTING PROHIBITED**

Regarding any related continuation/divisional application filed to pursue subject matter identical to or consonant with restriction/election subject matter not elected in or cancelled from the present application, it is respectfully submitted that the third sentence of 35 USC §121 and MPEP §804.01 prohibit a double-patenting rejection between this and any related continuation/divisional application(s).

**REJECTION UNDER 35 USC §103**

The 35 USC §103 rejection of Claims 37-39 as being unpatentable over Frechette *et al.* (US 4,868,638) in view of JP 64-76745 is respectfully traversed. Such rejection has been rendered obsolete by the present clarifying amendments to Applicant's Claim 37, and accordingly, traversal arguments are not appropriate at

this time. However, Applicant respectfully submits the following to preclude renewal of any such rejections against Applicant's clarified claims.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

Frechette *et al.* does not teach important features of the claimed invention, *e.g.*, a resin member or insulating tape. Further, JP 64-76745 does not combine with Frechette *et al.* to teach important features of the claimed invention, *e.g.*, the frame shape of an insulting tape, the tape being formed continuously between the suspension leads and the plurality of leads, as set forth in clarified Claim 37. See Figures 7 and 8, reference numbers 5,5A of JP 64-76745.

As a result of all of the foregoing, it is respectfully submitted that the applied art (taken alone and in the Office Action combinations) would not support a §103 obviousness-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §103 rejection, and express written allowance of all of the §103 rejected claims, are respectfully requested.

#### **EXAMINER INVITED TO TELEPHONE**

The Examiner is invited to telephone the undersigned at the local D.C. area number 703-312-6600, to discuss an Examiner's Amendments or other suggested action for accelerating prosecution and moving the present application to allowance.

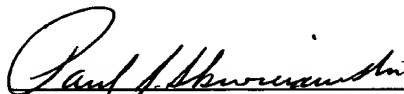


**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully submits that all of the claims listed above as presently being under consideration in this divisional reissue application are now in condition for allowance. Accordingly, allowance of all such claims is respectfully requested.

Applicant respectfully petitions the Examiner for an appropriate extension of the shortened statutory period for response set by the Office Action mailed 27 March 2003. A Form PTO-2038 authorizing payment of the requisite Petition fee is attached hereto. Please charge any deficits in fees to ATS&K Deposit Account No. 01-2135 (as Order No. 501.32049RV2).

Respectfully submitted,



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**ATTACHMENT:**

Forms PTO-2038 (Fee Code 1252)